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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: UEMURA=5

#17

In re Application of:) Art Unit: 1636
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) Hidetoshi UEMURA et al) Examiner: D. Sullivan
))
IA Date: November 19, 1999))
))
Appln. No.: 09/856,319) Washington, D.C.
))
Nationalized: May 21, 2001) Confirmation No. 6685
))
For: NOVEL SERINE PROTEASE) October 30, 2002
 BSSP5

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants are in receipt of Paper No. 16, a
restriction requirement Office Action mailed October 2,
2002.

The present application is the U.S. national phase
of international application PCT/JP99/06473 filed November
19, 1999, and claims priority from a Japanese application
filed November 20, 1998. Applicants have claimed priority
and, according to the form PCT/DO/EO/905, the PTO has
received a copy of the priority document from the
International Bureau. Accordingly, applicants respectfully

request acknowledgment by the PTO of the receipt of applicants' papers filed under §119.

Restriction has been required among what the PTO designates as five (5) patentably distinct inventions. As an election must be made even though traversed, applicants hereby respectfully and provisionally elect Group II, presently comprising claims 20-26, 32, 33, 38, 39, 42 and 43, with traverse and without prejudice.

The PTO recognizes that normal restriction practice does not apply, i.e. the standard to be applied is "unity-of-invention" per PCT Rules 13.1 and 13.2. However, and with respect, applicants believe that the arguments presented by the PTO in support of the requirement are based on standard restriction practice, rather than PCT Rules 13.1 and 13.2, even though the latter are referred to. In this regard, the IPER evidences no criticism on the basis of lack of unity-of-invention.

Further in this regard, it will be noted that claim 20, part of the elected subject matter, depends from and incorporates the subject matter of claim 35, part of non-elected Group II. Insofar as these two claims are concerned, from two separate groups, the common subject matter appears in claim 35, i.e. claim 35 defines the same

or corresponding special technical feature. Claims 22-25 also depend from claim 35, as do claims 32, 39 and 42.

Applicants respectfully request the examiner to again review the claims and their interrelationships. Applicants believe that upon such review, the examiner will see that there is a relationship whereby at least some of the groups (applicants believe all the groups) relate to a single general inventive concept under PCT Rules 13.1 and 13.2, whereby the requirement should be withdrawn and plural groups examined on the merits.

Even if normal restriction requirement practice were applicable in the present case, which it is not, the matter raised in the second paragraph of MPEP 803 would still need to be addressed. MPEP 803, second paragraph, **requires** examination of plural groups, even though the restriction requirement is correct, if it would not constitute a serious burden to do so. There is a clear interrelationship among the groups as pointed out above. Moreover, the Office Action does not indicate separate classification of the five groups. Accordingly, a second reason for withdrawal of the requirement is based on the second paragraph of MPEP 803.

Applicants respectfully request reconsideration and at least partial withdrawal of the requirement.

Applicants respectfully await the results of a first examination on the merits.

Respectfully submitted,

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